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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,262	04/23/2007	Marcel Nauer	041463-5042	6669
9629	7590	02/06/2008	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP			FAN, HONGMIN	
1111 PENNSYLVANIA AVENUE NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20004			2612	
			MAIL DATE	DELIVERY MODE
			02/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/588,262	NAUER, MARCEL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hongmin Fan	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 April 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10, 15 is/are rejected.  
 7) Claim(s) 11-14, 16 and 17 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

Claim 12 is objected to because of the following informalities: the claim 12 depends on claim 11 and one of claims 1-10 while the claim 11 already depends on one of claims 1-10. Appropriate correction is required.

Claims 13/12, 14/12 are objected due to their dependence to the claim 12.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (US 7245219).

As to claim 1, referring to Fig. 2, Tan et al disclosed a RFID tag comprising a substantially planar and electrically non-conductive substrate 22 having a mounting surface 24, a substantially planar and electrically conductive member 26 (i.e. external windings), a conductive bridge 28, a dielectric strip 30, and a semiconductor device 32. The substrate 22 has a spindle aperture 34 formed at a center portion 36. When mounted in alignment with the product such as, for example, a compact disc or the like (i.e. CD or DVD), the spindle aperture 34 enables the compact disc to couple to a spindle in a disc drive or to internal engagement members of a disc product carrier (col. 4, line 12-24). The conductive bridge 28 spans from the inner section free end 46 to the

outer section free end 52. With the dielectric strip 30 disposed between the conductive bridge 28 and the conductive member 26, three capacitive sections are thereby formed along the dielectric strip 30 (i.e. forming resonant circuit) (col. 4, line 51-56).

As to claim 2-3, referring to Fig. 2, Tan et al disclosed the conductive member 26 is mounted to the mounting surface 24 and comprises an inner section 38, an outer section 40 and a connecting section 42 that connects the inner section 38 to the outer section 40. The inner section 38 has windings 44 (col. 4, line 25-32).

As to claim 4-6, the claim is interpreted and rejected as claim 1.

As to claim 7, Tan et al did not disclose the substrate is transparent. However, it is well known compact disc has to use transparent substrate in order to allow light beam to read data.

As to claim 8, Tan et al disclosed the claim is interpreted and rejected as claim 1.

As to claim 9, Tan et al disclosed the RFID tag 20 is to receive interrogating signals at a desired resonant frequency of 13.56 Megahertz (MHz) within a 5% tolerance range (col. 5, line 4-8).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tan et al in view of Ono et al (US 6373799)

As to claim 10, Tan et al did not disclose means for lessening the influence of stray capacitances. However, it is well known in the art to lessen the influence of stray capacitances. Referring to Fig. 4A, Ono et al teach a optical disk (i.e. DVD) with a memory 3 (or tag) wherein it is even desirable to lower the electromagnetic coupling in order to minimize the influence of stray capacitance (col. 2, line 64-66). Therefore, it would have been obvious to one of ordinary skills in the art at the time of the invention to incorporate means to lessen the influence of stray capacitance in Tan's tag since it is well known in the art.

As to claim 15, Ono et al teach the metallic film (i.e. shielding surfaces) is expected to have a shielding effect for the transmission of electromagnetic wave.

### ***Allowable Subject Matter***

Claims 11, 13/11, 14/11, 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hongmin Fan whose telephone number is 571-272-2784. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HF

*DAVETTA W. GOINS*  
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PRIMARY EXAMINER